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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,214	02/08/2001	Stephen J. Boies	1963-5005	6637
48175	7590	12/17/2004	EXAMINER	
BMT/IBM FIVE ELM STREET NEW CANAAN, CT 06840			ALVAREZ, RAQUEL	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/779,214

Applicant(s)

BOIES ET AL.

Examiner

Raquel Alvarez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7-21 and 23-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-21 and 23-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

### DETAILED ACTION

1. This office action is in response to communication filed on 9/3/2004.
2. Claims 1-4, 7-21, 23-29 are presented for examination.

#### **Claim Rejections - 35 USC § 103**

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 7-21 and 23-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teper (5,815, 665 hereinafter Teper in view of Walker (6,405,174 hereinafter Walker).

With respect to claims 1, 15, 19-21, 23, 25 and 27-28, Teper teaches a method for providing a consumer service on a network service provider (Figure 1). Registering users with the aggregation service (col. 5, lines 26-30); granting the registered user access to the world wide web through the aggregation service (col. 5, lines 33-37); replacing the registered user's individual identity with the aggregation service identity as the user browses World Wide Web sites (col. 5, lines 33-37 and col. 6, lines 5-10).

With respect to the aggregation service collecting incentives from the merchant site and storing the incentives in a database for use by the users with the aggregation service. Walker teaches a method and apparatus for routing customers (title). In Walker the Outputting merchant collects the bonus from the soliciting merchant. The Outputting merchant outputs the offer to the customer once the customer satisfies a

predetermined criteria with the soliciting merchant. The bonus is to be redeemed through the Outputting merchant's site (col. 8, lines 19 to col. 9, lines 1-56 and col. 14, lines 56-62 and Figure 20). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the teachings of Walker of the aggregation service to collect and provide the incentives to the users because such a modification would allow the users to collect bonus and further make purchases from a known source.

With respect to claims 2, 24 and 26, Teper further teaches receiving transaction information for at least one registered user (Figure 2, 82); intercepting an electronic merchandise order placed by the registered user with a merchant through an electronic network (Figure 2, 84); charging the registered user for the order and executing the order with the merchant on the registered user's behalf so that the aggregation service's identity is charged by the merchant for the order (Figure 2, 88 and col. 11, lines 46-59); and storing information regarding each purchase in a database (col. 8, lines 63 to col. 9, lines 1-8).

Claims 3-4, 16 further recites that the aggregation service ships the purchased product to the user once the purchased product is received. Official notice is taken that it is old and well known for the customers to assign a third party to receive his/her merchandise and for the third party to ship or send the item to the purchaser. For example, a customer can assign a person to receive his/her merchandise when not at home and then that third person sends the merchandise to the purchaser. It would

have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the aggregation service ships the purchased product to the user once the purchased product is received in order to achieve the above mentioned advantage.

Claims 7-8 and 28 further recite awarding incentives points based on the order and allowing the users to trade-in the incentives points. Official notice is taken that is old and well known in marketing to distribute points to the consumers when the users purchase a certain amount of products or services in order to motivate the users to increase their purchases. It would have been obvious for a person of ordinary skill in the art at the time of Applicant's invention to have included awarding incentives points based on the order and allowing the users to trade-in the incentives points in order to obtain the above mentioned advantage.

With respect to claims 9-10, 12, Walker further teaches that the aggregation service includes volume incentives offered to the users based on the aggregate purchases made (Figure 8, 10). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included in the system of Teper the teachings of Walker of providing volume incentives based on the aggregate purchases made because such an incentive would motivate the consumers to make additional purchases knowing that the incentives offered is based on the purchases made.

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Claim 11 further recites that one of the incentive is upgrading a shipping order. Official notice is taken that is old and well known in marketing to upgrade on the method of shipping in order to motivate the users to make purchases. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included upgrading the method of shipping in order to obtain the above mentioned advantage.

With respect to claim 13, Walker teaches on Figure 11, requiring a purchase a required item, or product in order to obtain an incentive. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included requiring the customers to purchase a specific item because such a modification would allow the seller to specify the product that they want to sold.

With respect to claim 14, Walker teaches where buying one product entitles the customer to get a second product for a half price (see Figure 10, item 1022). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the teachings of Walker of receiving a product for half price when another product is purchased because such a modification would increase the amount of the product purchased.

Claim 17 further recites that the registered user physical address is only decodable by the shipping company. Official notice is taken that it is old and well known

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in encryption for certain entities to be able to decode certain data in order to provide data security. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included that the registered user physical address is only decodable by the shipping company in order to achieve the above mentioned advantage.

Claim 18 further recites permitting the user to specify the maximum price of items that the user is interested in purchasing. Official notice is taken that it is old and well known in buyers driven system for buyers to specify the maximum price that they are willing to pay for the items and for the sellers to bid for the customers. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included permitting the user to specify the maximum price of items that the user is interested in purchasing in order for the purchases to control the price on the items.

**Response to Arguments**

5. Applicant's arguments with respect to claims 1-4, 7-21 and 23-29 have been considered but are moot in view of the new ground(s) of rejection.

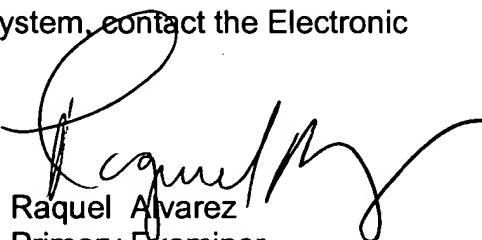
**Point of contact**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703)305-0456. The examiner can normally be reached on 9:00-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Raquel Alvarez  
Primary Examiner  
Art Unit 3622

R.A.  
12/10/04